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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			SHEIKH, ASFAND M	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,552

Applicant(s)

WARD ET AL.

Examiner

Asfand M. Sheikh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: z-shaped line found on pg. 17.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

2. Claims 1-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts;
and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the

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technological arts. In the present case, claims 1-29 only recite an abstract idea. The recited steps of processing orders based on purchaser and supplier does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to select an insurance policy over another.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "computerized processing of orders". Looking at the claim as a whole, nothing in the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

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Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention of managing purchasers and suppliers (i.e., repeatable) within computerized ordering system (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-29 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 28 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Erickson U.S. Pat. 6,014,644.

As per claim 28, Erickson discloses a) user identity means for storing user identity information relating to each of said users, at least part of which uniquely identifies each user from

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the other users (col. 8, lines 1-4 and col. 9, lines 29-37), b) primary data supply means for supplying one or more users with primary data (col. 11, lines 9-16 and col. 11, lines 57-61), c) secondary data selection criteria generating means for generating secondary data selection criteria for at least one user (col. 13, 60-67 and col. 14, lines 1-12), d) secondary data supply means for receiving said secondary data selection criteria and for supplying one or more of the users with secondary data concurrently or sequentially with the primary data (col. 11, lines 9-16 and col. 11, lines 57-61), e) recording means for recording data relating to the actions of at least one of the users supplied with said secondary data in the on-line system and for recording data relating to what secondary data was supplied to the user or each of said respective users (col. 14, lines 13-19), f) wherein said secondary data selection criteria includes information relating to the user identity information (col. 14, lines 19-25).

As per claim 29, Erickson discloses a) uniquely identifying users of the system with a unique identifier (col. 8, lines 1-4 and col. 9, lines 29-37), b) obtaining additional information relating to at least some of the users (col. 8, lines 1-4 and col. 9, lines 29-37), c) selecting and providing secondary data to users of the system concurrently or sequentially with the

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primary data (col. 13, 60-67 and col. 14, lines 1-12), d) recording information relating to actions of the users supplied with secondary data and information relating to what second data was supplied to each respective user (col. 14, 13-19), e) wherein the secondary data supplied to each user is selected at least in part using the unique identifier and/or at least part of said additional information (col. 14, lines 19-25).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson U.S. Pat. 6,014,644 in view of Giovannoli U.S. Pat. 5,758,328.

As per claim 1 and 14, Erickson discloses storage means for storing (col. 6, lines 42-45) (i) a master list of items, each item representing a product or service (col. 3 lines 12-15 and col. 7 lines 11-14), (ii) supplier details (col. 3, lines 15-17 and col. 7, lines 8-11), (iii) item sales terms for at lease one

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of the items for at least one of the supplies (col. 7, lines 11-14; Examiner interprets "information" to include item sales terms), (iv) purchaser details (col. 8, lines 1-4), and (v) purchaser terms for at least one of the purchasers for at least one of the suppliers (col. 8, lines 4-11), receiving means for receiving a purchaser identifier uniquely corresponding to one of the purchasers stored on the storage means (col. 9, lines 29-37), item selection criteria generating means for generating item selection criteria (col. 8, lines 28-32), extraction means for extracting an item sublist from the master list based on the generated item selection criteria (col. 8, lines 31-32; Examiner interprets "assemble list" to include extracting an item sublist from the master list), display means for displaying said item sublist to purchaser (col. 8, lines 32-34), and input means for selecting one or more desired items on the item sublist and for specifying desired quantities of said selected items (col. 13, lines 66-67 and col. 14, lines 1-15). However Erickson does not explicitly disclose supplier selection criteria generating means for generating supplier selection criteria, supplier selection means for receiving said desired item information and respective desired quantity information and said supplier selection criteria for selecting at least one supplier for each of the desired items, based on supplier selection criteria, said

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desired item information and respective desired quantity information, and supplier selection criteria includes at least one of the following: (i) purchaser supplied criteria (ii) criteria obtained from the stored item sales terms. However, Giovannoli discloses supplier selection criteria generating means for generating supplier selection criteria (col. 5, lines 12-15), supplier selection means for receiving said desired item information and respective desired quantity information and said supplier selection criteria for selecting at least one supplier for each of the desired items, based on supplier selection criteria, said desired item information and respective desired quantity information (col. 5, lines 12-18), and supplier selection criteria includes at least one of the following: (i) purchaser supplied criteria (ii) criteria obtained from the stored item sales terms (col. 5, lines 12-15).

It would be obvious to one skilled in the art at the time the invention was made to modify Erickson's method to include supplier selection criteria generating means for generating supplier selection criteria, supplier selection means for receiving said desired item information and respective desired quantity information and said supplier selection criteria for selecting at least one supplier for each of the desired items, based on supplier selection criteria, said desired item

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information and respective desired quantity information, and supplier selection criteria includes at least one of the following: (i) purchaser supplied criteria (ii) criteria obtained from the stored item sales terms as taught by Giovannoli. The motivation to combine would allow for processing requests for goods and services through a computer based communication network based on filter conditions thereby providing a larger market of suppliers and purchasers (col. 2, lines 62-65).

As per claim 2 and 15, Erickson discloses the item sale terms include and, or all of: whether a particular supplier supplies the respective item, price levels, stock levels, freight chargers, geographic limitations on supply (col. 9, lines 50-53).

As per claim 3 and 16, Erickson discloses the item selection criteria return all available items, whether in stock or not (col. 9, lines 58-60; Examiner interprets "all products" to include all inventory whether in stock or not provided by a supplier).

As per claim 4 and 17, Erickson discloses the item selection criteria includes the purchaser details or purchaser terms for at least some of the stored vendors (col. 7, lines 50-56, col. 8, lines 4-11, and col. 8, lines 28-30).

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As per claim 5 and 18, Erickson does not explicitly disclose the supplier selection criteria includes purchase details or purchase terms or both. However, Giovannoli discloses the supplier selection criteria includes purchase details or purchase terms or both (col. 5, lines 15-18).

It would be obvious to one skilled in the art at the time the invention was made to modify Erickson's method to include the supplier selection criteria includes purchase details or purchase terms or both as taught by Giovannoli. The motivation to combine is the same as claim 1 above.

As per claim 6 and 19, Erickson discloses the purchaser terms for each supplier/purchaser combination includes any or all of: whether the supplier will supply the purchaser, minimum orders, freight charges, sales terms, price bands (col. 13, lines 66-67 and col. 14, lines 1-6).

As per claim 7 and 20, Erickson discloses the item selection criteria further include restrictions retrieved from the purchaser's purchase terms so as to restrict the items on the available item sublist to those items available from suppliers who have indicated that they will supply the particular purchaser (col. 3, lines 46-51).

As per claim 8 and 21, Erickson does not explicitly disclose the supplier selection criteria include restrictions

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retrieved from the purchaser terms. However, Giovannoli discloses the supplier selection criteria include restrictions retrieved from the purchaser terms (col. 5, lines 15-18).

It would be obvious to one skilled in the art at the time the invention was made to modify Erickson's method to include the supplier selection criteria include restrictions retrieved from the purchaser terms as taught by Giovannoli. The motivation to combine is the same as claim 1 above.

As per claim 9 and 22, Erickson does not explicitly disclose the supplier selection criteria result in the selected supplier for a desired item being the supplier with the lowest price per unit of the item. However, Giovannoli discloses the supplier selection criteria result in the selected supplier for a desired item being the supplier with the lowest price per unit of the item (col. 5, lines 15-18).

It would be obvious to one skilled in the art at the time the invention was made to modify Erickson's method to include he supplier selection criteria result in the selected supplier for a desired item being the supplier with the lowest price per unit of the item as taught by Giovannoli. The motivation to combine is the same as claim 1 above.

As per claim 10 and 23, Erickson does not explicitly disclose the lowest price is the base price or it may be an

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effective price after allowing for any of the following:
freight, available discounts, bonuses. However, Giovannoli discloses the lowest price is the base price or it may be an effective price after allowing for any of the following:
freight, available discounts, bonuses (col. 6, lines 47-57; Examiner interprets "on sale" to be an available discount representing the lowest price on an item).

As per claim 11 and 24, Erickson does not explicitly to disclose the supplier selection criteria includes purchasers supplied criteria and said purchaser supplied criteria includes any or all of the following: a selected supplier, two or more suppliers, suppliers from a specified geographic location or locations, and delivery times. However, Giovannoli discloses the supplier selection criteria includes purchasers supplied criteria and said purchaser supplied criteria includes any or all of the following: a selected supplier, two or more suppliers, suppliers from a specified geographic location or locations, and delivery times (col. 7, lines 3-15).

It would be obvious to one skilled in the art at the time the invention was made to modify Erickson's method to include the supplier selection criteria includes purchasers supplied criteria and said purchaser supplied criteria includes any or all of the following: a selected supplier, two or more

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suppliers, suppliers from a specified geographic location or locations, and delivery times as taught by Giovannoli. The motivation is the same as claim 1 above.

As per claim 12 and 25, Erickson does not explicitly disclose the purchaser supplied criteria includes criteria to obtain quotations from two or more suppliers for all items on the desired item list supplied by the respective supplier. However, Giovannoli discloses the purchasers supplied criteria included criteria to obtain quotations from two or more suppliers for all items on the desired item list supplied by the respective supplier (col. 7, lines 48-50).

It would be obvious to one skilled in the art at the time the invention was made to modify Erickson's method to include the supplier selection criteria includes purchasers supplied criteria and said purchaser supplied criteria includes any or all of the following: a selected supplier, two or more suppliers, suppliers from a specified geographic location or locations, and delivery times as taught by Giovannoli. The motivation is the same as claim 1 above.

As per claim 13 and 26-27, Erickson does not explicitly to disclose the means to transmit orders to a selected supplier or suppliers for provision of ordering items. However, Giovannoli

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discloses the means to transmit orders to a selected supplier or suppliers for provision of ordering items (col. 6, lines 2-6).

It would be obvious to one skilled in the art at the time the invention was made to modify Erickson's method to include the means to transmit orders to a selected supplier or suppliers for provision of ordering items as taught by Giovannoli. The motivation to combine is the same as claim 1 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asfand M. Sheikh whose telephone number is (571) 272-1466. The examiner can normally be reached on M-F 7a-3:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Asfand M Sheikh
Examiner
Art Unit 3627

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PRIMARY EXAMINER